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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,588	05/04/2001	Shigeaki Kato	046124-5006-01-US	1925

9629 7590 09/10/2002

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EXAMINER

MURPHY, JOSEPH F

ART UNIT PAPER NUMBER

1646

DATE MAILED: 09/10/2002 4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,588

Applicant(s)

KATO ET AL.

Examiner

Joseph F Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Formal Matters

Claims 1-6 and 9-13 were cancelled, claims 7 and 8 were amended, and new claims 14-17 were added in Paper No. 2, 5/4/2001. Claims 7-8, 14-17 are pending and under consideration.

Claim Rejections - 35 USC § 112 second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 16 are vague and indefinite in the recitation of the terms "p300" and "CBP". There is no definition within the claim, and insufficient guidance in the specification, as to define the protein to which these acronyms refer. Thus, the metes and bounds of these claims cannot be determined

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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Claims 7-8, 15-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Pouponnot et al. (1998).

Pouponnot teaches a method of detecting interactions between Smads 1, 2 and 3 and the transcription coupling factor p300 using GST-fusion proteins in HaCaT cells or 293T cells (page 22866, Figure 1C and D). Pouponnot teaches the use of a GAL4-Smad2 fusion protein to measure the interaction between Smad2 and the transcription coupling factor p300 in the presence of either wild type adenovirus E1A protein or an E1A mutant which is defective in p300 binding. The transactivating function of Smads was inhibited by wild-type E1A and this inhibition specifically required the p300 binding function of E1A (page 22867, Figure 3). The teaching of Pouponnot thus anticipates claims 7-8, 15-16 by setting forth a method for measuring the effects on activity of a substance to be tested (i.e. E1A protein) on the interaction between a Smad molecule and a transcription coupling factor (i.e. p300) in a culture system (i.e. HaCaT cells).

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Claims 7-8, 14-17 are rejected under 35 U.S.C. 102(a) as being anticipated by Janknecht et al. (1998).

Janknecht teaches that Smad proteins utilize CBP/p300 to exert their effects. The transcription factor Smad3 binds to CBP/p300 both in vivo and in vitro (page 2114, column 2, third paragraph). Janknecht teaches the use of 293T cells cotransfected with expression vectors encoding Smad3 and a deletion mutant of CBP, CBP₁₈₉₁₋₂₁₇₅. Luciferase activity is measured from a reporter construct (page 2116, Figure 3). CBP₁₈₉₁₋₂₁₇₅ competes with endogenous CBP/p300 for Smad proteins, by acting as a dominant negative molecule, and thereby interferes with Smad3 activity (page 2117, column 1 first paragraph).). The teaching of Janknecht thus anticipates claims 7-8, 14-17 by setting forth a method for measuring the effects on activity of a substance to be tested (i.e. CBP₁₈₉₁₋₂₁₇₅ protein) on the interaction between a Smad3 molecule and a transcription coupling factor (i.e. CBP) in a culture system (i.e. 293T cells).

Conclusion

No claim is allowed.

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Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245.

The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
September 5, 2002